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#10

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/077,194 12/04/98 BOHN

M 02481.1596

HM12/1014

FINNEGAN HENDERSON FARABOW  
GARRETT AND DUNNER  
FRANKLIN SQUARE BLDG SUITE 700  
1300 I STREET N W  
WASHINGTON DC 20005-3315

EXAMINER

KIM, V

ART UNIT

PAPER NUMBER

1614

DATE MAILED:

10/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

RECEIVED

OCT 18 1999

FINNEGAN, HENDERSON, FARABOW,  
GARRETT AND DUNNER, LLP

Docketed 10-18-99 Attorney CPE-GRS-JZS  
Case 2481-1596  
Due Date 1-14-00 w/ ext  
Action Final Resp in appeal  
By WAS

OCT 19 1999

# Office Action Summary

Application No.  
09/077,194

Applicant(s)  
Bohn et al

Examiner  
Vickie Kim

Group Art Unit  
1614



☐ Responsive to communication(s) filed on \_\_\_\_\_

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 27-30 and 32-37 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 27-30 and 32-37 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Status of Application***

1. Acknowledgment is made for amendment filed on September 21, 1999.
2. Claims 27-30 and 32-37 are pending.
3. Claims 14-26 and 31 are canceled.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 27-30, have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 27-30 and 32-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Lohaus et al (US 4,797,409).

Claims read on a pharmaceutical composition comprising 1-hydroxy-2-pyridone of formula I.

Lohaus et al.(US'409) teach all the critical elements required by the instant claims.

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7. It is noted that **a recitation of the intended use of the claimed invention must result in a structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. **If the prior art structure is capable of performing the intended use, then it meets the claim.** See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In other words, the recitation "treatment for seborrheic dermatitis" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

For the PH range required by the instant claims, the patented composition has same PH range because it is inherently possessed properties when the patented composition comprises exactly same ingredients, even though the cited patent didn't expressly suggest the claimed invention.

Thus the claimed subject matter is not patentably distinct over the prior references.

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*Conclusion*

8. All the pending claims 27-30 and 32-37 are rejected.
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

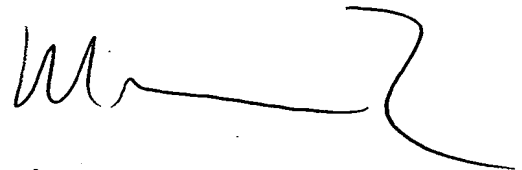
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Vickie Kim* whose telephone number is (703)305-1675.



*Vickie Kim*, patent examiner

October 7, 1999



MARIANNE M. CINTAS  
VICTORY PATENT EXAMINER  
GROUP 120